

**REMARKS**

**STATUS OF THE CLAIMS**

Claims 1, 5-11, 14-16, 19, 22-24, 31, 32 and 34-37 were pending and claims 1, 7-11, 14-16, 19, 23 and 24 were under active examination. As shown above, claim 1 has been amended to recite that the vaso-occlusive member is a vaso-occlusive coil, as described throughout the as-filed specification and in original claim 1. Dependent claims 11, 14, 15 and 16 have been amended to properly depend from amended claim 1. No new matter is added as result of this amendment and as the claims previously recited such structures, no new search is required. Accordingly, entry of the foregoing amendments and examination of claims 1, 7-11, 14-16, 19, 23 and 24 as shown above are requested.

**35 U.S.C. § 102(b)**

Claims 1, 7, 11, 19, 23 and 24 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Schwartz '971. (Office Action, page 2). Schwartz was cited for allegedly disclosing "a vaso-occlusive coil for treating aneurysms having a fibrin/thrombus stabilizing molecule, e.g., Factor XIII, bioactive coating (see, figures 1-3 and claims 2 and 3)." *Id.*

In response to Applicants' previous arguments that Schwartz '971 is silent as to vaso-occlusive devices, the Final Office Action states (page 5):

...[T]he law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USP 781 (CCPA 1983).

In addition, various cases were cited in support of the assertion that functional limitations or properties can never distinguish claims over a cited reference. See, page 5 of the Final Office Action.

In point of fact, anticipation is a rigorous standard – every limitation of the claim at issue must appear identically in a single reference for a rejection under 35 U.S.C. § 102 to stand. *In re Bond*, 910 F.2d 831, 832, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990). Moreover, contrary to the Examiner's assertion an anticipation rejection is not appropriate where the claims recite a property that distinguishes the claimed structure from that disclosed in the cited reference. See,

*In re Pearson*, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974). A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. See, e.g., MPEP § 2173.05(g).

The pending claims require the inclusion of a vaso-occlusive coil. Contrary to the Examiner's assertions, the functional limitation "vaso-occlusive" must be considered for what it fairly conveys to the skilled artisan. Here, Applicants have repeatedly addressed how a "vaso-occlusive" structure cannot, under any interpretation, include a stent because occlusive structures occlude a vessel and stents keep a vessel open to blood flow. Additional evidence, including dictionary definitions, is also of record establishing that stents are the complete opposite of a vaso-occlusive composition. See, Response filed November 22, 2002 (received December 2, 2002) and Appeal Brief (received December 7, 2005). When properly considered, it is clear that the claimed vaso-occlusive devices are not disclosed in a reference relating entirely to stents. Accordingly, anticipation cannot be established.

Furthermore, the cases cited by Examiner (*In re Otto*, *In re Casey*) in support of the allegation that functional limitations are not considered in an anticipation inquiry are irrelevant to the instant case. These cases addressed situations in which the structure disclosed in the cited reference was capable of being used in the same way as the claimed structure. By contrast, in the pending case, the stent structures of Schwartz '971 are not "capable of use" as vaso-occlusive coils because, by definition, a stent is the opposite of a vaso-occlusive coil. Thus, Schwartz's stent structures can never be used as occlusive devices and, again, anticipation of the claims as pending cannot be established.

In sum, Schwartz '971 is entirely silent as to vaso-occlusive coils as claimed, teaching instead the opposite of a vaso-occlusive device, namely a stent. Moreover, the stents disclosed in the reference are not capable of being used as occlusive devices, as set forth in the pending claims. Accordingly, this reference does not in any way teach or describe the claimed subject matter and withdrawal of this rejection is in order.

**35 U.S.C. § 103**

**A. Claims 9 and 10**

Claims 9 and 10 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over Schwartz '971 in view of U.S. Patent No. 4,414,976 (hereinafter "Schwarz '971"). (Office Action, pages 2-1). Schwartz '971 was cited as above for teaching all the elements of claims 9 and 10 except plasminogen activator inhibitor. *Id.*

For the reasons detailed above, Schwartz '971 **teaches away** from the claimed occlusive compositions. In fact, every previous rejection based on a reference disclosing a stent has been withdrawn by the Office because such references teach away from the claimed occlusive compositions.

Thus, for all the reasons of record regarding references that teach coating stents to prevent occlusion, withdrawal of the rejection is in order.

**B. Claim 14**

Claim 14 was rejected as allegedly obvious over Schwartz '971 in view of U.S. Patent No. 6,231,590 (hereinafter "Slaikeu"). (Office Action, page 3). Schwartz '971 was cited as above and Slaikeu was cited for teaching plasma treated devices. (Office Action, page 6).

For the reasons listed above, Schwartz '971 does not disclose and actually teaches away from the claimed subject matter. Accordingly, the rejection cannot be sustained.

**B. Claim 15**

Claim 15 was rejected as allegedly obvious over Schwartz '971 in view of U.S. Patent No. 5,891,192 (hereinafter "Murayama"). (Office Action, page 4). Schwartz '971 was cited as above with regard to claim 14 and Murayama was cited for teaching ion implantation. *Id.*

Since Schwartz teaches away from the claimed occlusive compositions, withdrawal of the rejection is in order.

**C. Claim 16**

Claim 16 was rejected as allegedly obvious over Schwartz '971 in view of U.S. Patent No. 6,526,979 (hereinafter "Nikolchev"). (Office Action, page 4). Schwartz '971 was cited as above and Nikolchev was cited for teaching microtexturing. *Id.*

For the reasons listed above, Schwartz does not teach or suggest the compositions of claim 16 and, therefore, the rejection is untenable.

**CONCLUSION**

For the reasons discussed above, Applicants submit that the claims are in condition for allowance and request early notification to that effect.

If the Examiner has any further issues or wishes to discuss any of the foregoing, she is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

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